

Paper No. 10  
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THIS DISPOSITION IS  
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MAY 26, 99

U.S. DEPARTMENT OF COMMERCE  
PATENT AND TRADEMARK OFFICE

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Trademark Trial and Appeal Board

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In re Michael Brian Hinden and  
Janeen Mary Judge

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Serial No. 75/100,086

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Evelyn M. Sommer of Skadden, Arps, Slate, Meagher & Flom  
LLP for Michael Brian Hinden and Janeen Mary Judge.

Montia O. Givens, Trademark Examining Attorney, Law Office  
101 (R. Ellsworth Williams, Managing Attorney).

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Before Cissel, Hohein and Hairston, Administrative  
Trademark Judges.

Opinion by Hairston, Administrative Trademark Judge:

Michael Brian Hinden and Janeen Mary Judge have filed  
an application to register the mark NEW YORK WATER for  
"bottled drinking water."<sup>1</sup>

Registration has been refused under Section 2(e)(2) of  
the Trademark Act, 15 U.S.C. §1052(e)(2), on the ground

that the mark is primarily geographically descriptive of the identified goods.

When the refusal was made final, applicants appealed. The case has been fully briefed, but no oral hearing was requested.

In order for registration to be properly refused under Section 2(e)(2) of the Trademark Act, it is necessary to establish that (1) the primary significance of the mark sought to be registered is the name of a place generally known to the public and (2) the public would make a goods/place association, that is, believe that the goods for which the mark is sought to be registered originate in that place. See, e.g., *University Book Store v. University of Wisconsin Board of Regents*, 33 USPQ2d 1385, 1402 (TTAB 1994); and *In re California Pizza Kitchen, Inc.*, 10 USPQ2d 1704, 1705 (TTAB 1988) citing *In re Societe Generale des Eaux Minerales de Vittel S.A.*, 824 F.2d 957, 3 USPQ2d 1450, 1452 (Fed. Cir. 1987). If these conditions are met, and the goods come from the place named by or in the mark, the mark is primarily geographically descriptive. Moreover, where there is no genuine issue that the geographical significance of a term is its primary significance, and

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<sup>1</sup> Application Serial No. 75/100,068 filed May 7, 1996; asserting a bona fide intention to use the mark in commerce. The word

where the geographical place named by the term is neither obscure or remote, a public association of the goods with the place may ordinarily be presumed from the fact that the applicant's goods come from the geographical place named in the mark. See, e.g., *In re California Pizza Kitchen Inc.*, *supra*; and *In re Handler Fenton Westerns, Inc.*, 214 USPQ 848, 850 (TTAB 1982). Also, the presence of a generic or highly descriptive term in a mark which also contains a primarily geographic descriptive term does not serve to detract from the primary geographic significance of the mark as a whole. See, e.g., *In re Cambridge Digital Systems*, 1 USPQ2d 1659, 1662 (TTAB 1986); and *In re BankAmerica Corp.*, 231 USPQ 873, 875 (TTAB 1986).

With respect to the geographic significance of the term NEW YORK, applicants argue that NEW YORK has "a further meaning in addition to its geographical significance." (Brief, p. 2) In particular, applicants maintain that NEW YORK conveys a "big city" feeling to its product, and that "it is the grandness, the excitement, and the best-in-the-world impression one would get from the term NEW YORK that is intended to be imported to applicant's products by the use of the mark 'NEW YORK WATER.'" (Brief, p. 3).

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"WATER" has been disclaimed apart from the mark as shown.

In this case, however, we agree with the Examining Attorney that the primary connotation of the term NEW YORK, as used in the mark NEW YORK WATER, is geographical. In this regard, the Examining Attorney offered a definition from The Random House Dictionary of the English Language (1987) which shows that New York is a place that is neither obscure or remote. Also, we note that applicants have disclaimed exclusive rights to the word "WATER," thereby conceding the genericness of this word in connection with bottled drinking water.

We find, therefore, that the primary significance of NEW YORK WATER to the public would be its geographical significance.

Turning then to the second part of the test for geographical descriptiveness, applicants maintain that the public would not make the requisite goods/place association; i.e., believe that the applicants' goods originate in NEW YORK. Applicants contend that New York is not noted for its drinking water.

However, as noted above, absent a genuine issue that the term is remote or obscure or that its primary significance is other than geographical, a goods/place

association may be presumed from the fact that applicant's goods will come from the place named in the mark.<sup>2</sup> As

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<sup>2</sup> Applicants have indicated that their bottled drinking water will come from New York City.

discussed above, there is no genuine issue that New York City is not a remote or obscure geographical location, and that, as used in applicants' mark, the primary significance of NEW YORK is geographical.

We note that the Examining Attorney also contends that there is a goods/place association here because New York's drinking water has been highly rated in taste tests. In this regard, she submitted excerpts from the NEXIS data base which concern New York's drinking (tap) water. While we are not persuaded that such evidence establishes a goods/place association between bottled drinking water and New York, it is unnecessary in this case because a goods/place association may be presumed from the fact applicant's goods will come from New York. We should add that if applicants' bottled drinking water were to originate in some place other than New York, then the mark NEW YORK WATER would be geographically misdescriptive of applicants' goods.

We find therefore that NEW YORK WATER is primarily geographically descriptive of applicants' bottled drinking water.<sup>3</sup>

**Decision:** The refusal to register is affirmed.

R. F. Cissel

G. D. Hohein

P. T. Hairston  
Administrative Trademark  
Judges, Trademark Trial and  
Appeal Board

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<sup>3</sup> This case is readily distinguishable from *In re Jim Crockett Promotions Inc.*, 5 USPQ2d 1455 (TTAB 1987) [THE GREAT AMERICAN BASH is not primarily geographically descriptive of promoting professional wrestling matches]. In *Crockett*, the term GREAT AMERICAN was found to suggest some desirable quality or excellence and BASH was not generic or highly descriptive of services involving wrestling matches.

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